

Agilent Ref: 10971150-2
United States Application Serial No. 10/080,641

REMARKS

In view of the above amendments and the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 32, 33, 36-38 and 43-52, the only claims pending and currently under examination in this application.

Claims 32, 38, 43 and 47 are amended for clarity and to specify that the features on the arrays being scanned are bipolymeric features. Support for this amendment can be found throughout the specification, specifically page 1, lines 4-6 and page 6, lines 1-3. Claim 48 is amended for clarity.

As no new matter is added by way of these amendments, entry thereof by the Examiner is respectfully requested.

Claim Rejections – 35 USC § 103

Claims 32, 33, 38, 43, 44, and 47-50 are rejected as unpatentable under 35 U.S.C. § 103(a) over Peters (US 6,118, 532) in view of Kaye (US 3,850,525) and Modell (US 6,826,422) and further in view of *In re Venner*.

As stated in MPEP § 2142:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner asserts that Peters teaches an apparatus comprising a plurality of adjustable detectors which detect scattered light from an illuminated sample but fails to teach detection of light of a different wavelength than the interrogating light. To fill this deficiency, the Examiner cites Kaye and Modell asserting that they teach an apparatus for detecting light at different detection angles in which the detected light can be of a different wavelength than the interrogating light and detectors with emission filters. The Examiner notes that none of these cited references teach a processor for correlating the detected data with the respective biopolymeric features on the array. However, citing *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958), the Examiner asserts that because this element of the claims is drawn

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to descriptive material stored on or employed by a machine having no functionality related to the invention, it does not distinguish the invention over the cited prior art.

In response, the Applicants submit that the claims as currently amended are patentable over the cited prior art as discussed below.

First, the rejected claims are drawn to an apparatus for scanning arrays of multiple features of different biopolymeric moieties. The Applicants submit that none of the cited references teach or suggest an apparatus capable of scanning biopolymeric arrays. As such, for at least this reason, the rejected claims are patentable over the cited references.

Second, the rejected claims are drawn to an apparatus for scanning biopolymeric arrays, where the apparatus includes a processor which receives signals from the detector system and correlates them with respective array features. As stated above, the Examiner notes that none of the cited references teach or suggest such a processor. Nonetheless, the Examiner asserts that this element in itself does not distinguish over the prior art citing *In re Venner*.

However, the Applicants submit that the processor element provides distinct and significant functionality to the claimed invention. Specifically, the processor serves the function of analyzing the detector signals in such a way as to correlate them with distinct biopolymeric features that have been deposited on the array. As biopolymeric arrays can contain any number of different biopolymeric moieties and/or patterns in which the biopolymeric are deposited, this feature imparts significant functionality to the claimed apparatus.

Furthermore, as mentioned above, none of the cited references are drawn to a biopolymeric array scanner and as such they would not function as intended with a processor as is claimed. As stated in MPEP § 2143.01:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

As such, the processor element of the claimed invention is not rendered obvious by the cited references and for at least this reason, the claimed invention is patentable over the cited references.

Therefore, because the cited references fail to teach or suggest each and

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every element of the claimed invention, the Applicants respectfully request withdrawal of the rejection of Claims 32, 33, 38, 43, 44, and 47-50 as unpatentable under 35 U.S.C. § 103(a).

Claims 36, 37, 45, 46, 51 and 52 are rejected as unpatentable under 35 U.S.C. § 103(a) over Peters in view of Kaye, Modell and Roustaei (US 6,123,261) and further in view of *In re Venner*.

With regard to the subject claims, the Examiner states that Peters, Kaye and Modell fail to teach: 1) a processor for correlating received signals from the detectors with respective array features; 2) a reader to read a code on the array unit; and 3) a scanning system which scans the interrogating light. To fill these deficiencies, the Examiner cites Roustaei, asserting that this reference teaches an optical scanning device system for reading encoded information comprising a scanner, reading device and a processor used to decode the scan data.

In response, the Applicants submit that the rejected claims are drawn to an apparatus for scanning arrays of multiple features of different biopolymeric moieties and that none of the cited references teach or suggest an apparatus capable of scanning biopolymeric arrays. As such, for at least this reason, the rejected claims are patentable over the cited references.

Next, the Applicants submit that Roustaei fails to teach or suggest a processor which receives signals from the detector system and correlates them with respective array features. As noted above, the claimed processor element is specifically configured to correlate the scan data with the biopolymeric features on the scanned array and not for decoding scanned symbology as is the processor of Roustaei. Indeed, incorporating the processor of the claimed invention into the apparatus of Roustaei would render Roustaei's apparatus inoperable. Therefore, in accordance with MPEP § 2143, Roustaei fails to teach or suggest the claimed processor and for at least this reason, the claimed invention is patentable over the cited references.

Finally, Claims 36, 45, and 51 are drawn to an apparatus that includes the elements of "a reader to read a code carried by an array unit, and a processor which causes the detector system to detect emitted light at a detection angle based on the

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read code." The Applicants can find no statement provided by the Examiner that indicates that this element is taught or suggested by the cited references. In the absence of a specific citation of a teaching or suggestion of this element, the Applicants submit that the cited references fail to make these claims obvious.

Therefore, because the cited references fail to teach or suggest each and every element of the claimed invention, the Applicants respectfully request withdrawal of the rejection of Claims 36, 37, 45, 46, 51 and 52 as unpatentable under 35 U.S.C. § 103(a).

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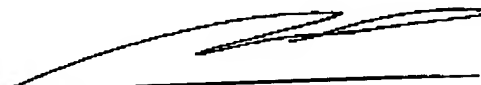
CONCLUSION

The Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078 order no. 10971150-2.

Respectfully submitted,

Date: 5.2.05

By: 
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